Applicants provisionally elect to prosecute the claims to the intermediate compounds of Group II. Claims 14 through 17 are directed to the subject matter of Group II. The election is made with traverse.

Applicants have cancelled all claims last presented and are submitting new claims 10 through 17. Antecedent basis for the new claims may be found in the specification on pages 3 through 6.

Applicants believe that process of preparation claims 10 through 13 of Group I should be examined together with the intermediate compound claims 14 through 17 of Group II. The Examiner argues that the process of preparation claims and the intermediate compound claims should not be examined together because there is no common technical feature between process variants (a) and (b) of Group I and the nitro-substituted intermediates of the Formula (II) of Group II. There is indeed a common technical feature among both the new process of preparation claims and the claims to the intermediate Formula (II) compounds. Applicants have found that where an intermediate compound of the Formula (II) where R is hydrogen as in process variant (a) or R is benzyl, diphenylmethyl or aryl unsubstituted or substituted by alkyl or alkoxy as in process variant (b), the intermediate compound is hydrogenated in an inert organic solvent at a temperature of 10 to 50°C under 1 to 20 kPa pressure to directly obtain the desired 1-(aminomethyl)-cyclohexyl-acetic acid in the inert organic solvent in high purity without formation of the spirolactam as shown in col. 5, line 40 of U.S.

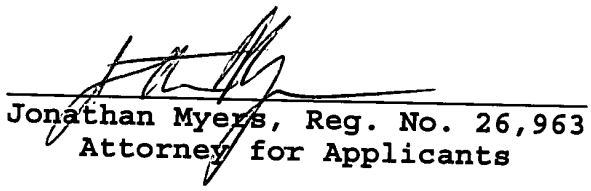
Patent 5,091,567 to GEIBEL et al. See page 4, lines 12 to 17 of the present application.

According to GEIBEL et al in col. 5, lines 30 to 40 when the starting compound in step (c) of the reference process is the ethyl ester instead of the free acid, or the benzyl, diphenylmethyl or aryl ester of the present Formula (II) the principal product obtained is the spirolactam which must then be treated with an acidic ion exchanger to eventually obtain the desired 1-(aminomethyl)-cyclohexyl-acetic acid. Only a small amount of the 1-(aminomethyl)-cyclohexyl-acetic acid is obtained by direct hydrogenation of the ethyl ester according to GEIBEL et al.

Both the compound of the present Formula (II) where R is hydrogen (Formula IIa) or the compound of the Formula (II) where R is benzyl, diphenylmethyl or aryl (Formula IIb) are key to successfully carrying out step (a) of new claim 10 to obtain the desired 1-(aminomethyl)-cyclohexyl-acetic acid without the lactam formation. Thus there is a common technical feature between the hydrogenation step (step a) of process of preparation claim 10 and the new intermediate compounds of the Formula (II) which are the starting materials for the process of claim 10. In claims 10 through 13 Applicants have included the common feature from both process variants (a) and (b) and combined both process variants into one claim to further emphasize the importance of this common feature. All of the new claims 10 through 17 should therefore be examined together in one application.

An action on the merits is awaited. Applicants are enclosing a petition to obtain a one month extension of the term for response and payment authorization to cover the cost of obtaining the extension.

Respectfully submitted,
The Firm of Karl F. Ross P.C.



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Enclosure: Extension Petition